



Docket: 102105.151CI
USSN: 08/482,402
page 1 of 7
D A C
1642

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application:

Rapoport

U.S. Serial No. 08/482,402

CPA Filed: 06/07/95

For: **DISEASE ASSOCIATED HUMAN
AUTOANTIBODIES SPECIFIC FOR
HUMAN THYROID PEROXIDASE**

/ allowed: 05/01/2002
/ batch: 2315
/
/ Group Art Unit: 1642
/ Examiner: S. Ungar

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MAY 20 2003

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TECH CENTER 1600/2900

PETITION FOR RECONSIDERATION OF PETITION DECISION

Dear Sir:

This is a petition for reconsideration of the petition decision mailed on May 7, 2003.

On July 24, 2003, the Patent & Trademark Office (PTO) received an issue fee transmittal filed by Applicant, authorizing the PTO to charge the issue fee to Deposit Account 13-5135. The issue fee was due on August 1, 2002, so the issue fee transmittal was timely filed.

On September 20, 2002, two months after the issue fee was paid, Applicant received a Notice of Abandonment dated September 16, 2002, which indicated only that the subject application was abandoned for failure to pay the issue fee. No explanation was provided as to the basis for this decision. Consequently, Applicant assumed that the issue fee transmittal filed on July 24, 2002 had been misdirected, or otherwise not matched with the application, and promptly filed a Petition for Reinstatement of Improperly Abandoned Application on October 1, 2002. This petition merely explained that the Notice of Abandonment was mistaken, since the issue fee

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transmittal had indeed been filed, and included a copy of the issue fee transmittal, together with a copy of the return receipt postcard, evidencing its timely filing.

Immediately upon the filing of this petition, on October 3, 2002, the issue fee for the subject application, in the amount of \$1,280, was charged to the aforementioned deposit account. A copy of the Deposit Account Statement evidencing this charge is attached hereto as Exhibit A.

Surprisingly, TWO MONTHS AFTER THE ISSUE FEE HAD BEEN CHARGED TO THE DEPOSIT ACCOUNT OF THE UNDERSIGNED, a Petition Decision was issued on December 2, 2002, denying Applicant's petition of October 1, 2002 and maintaining the abandoned status of the subject application, on the basis that there had been insufficient funds in the authorized deposit account on the date on which the PTO had attempted to charge the authorized issue fee. It was therefore held that the issue fee had not been timely paid. This was the first time, almost FIVE MONTHS AFTER THE ISSUE FEE WAS INITIALLY AUTHORIZED, Applicant had been advised of the facts and circumstances which had actually caused the application to be initially abandoned. The Petition Decision never referenced the fact that, two months earlier, the PTO had proceeded to charge the issue fee to the undersigned's deposit account, which charge has never been reversed. In fact, it incorrectly stated that "Applicant resubmitted the Issue Fee on October 1, 2002, however this was after the due date for payment thereof". Applicant never, in fact, resubmitted the Issue Fee. The submittal of October 1, 2002 was merely a request for vacating the holding of abandonment, because the Issue Fee had been timely paid. A copy of the originally submitted Issue Fee was enclosed to back up that contention.

Applicant filed a request for reconsideration on December 27, 2002, and subsequently filed a second request for reconsideration on January 14, 2003. The second request for reconsideration was prompted when the undersigned became aware, through inspection of deposit account statements, that the PTO was continuing to hold the subject application abandoned while it had

in fact also accepted payment of the issue fee. Strangely, the Petition Decision of May 7, 2003, which took another FOUR MONTHS to render, does not even reference the second request for reconsideration, a copy of which is attached hereto as Exhibit B, and responds only to the first request of December 27, 2002. Again, in the Petition Decision of May 7, it is incorrectly stated that Applicant "resubmitted the Issue Fee on October 1, 2002". It is clear that the decider of the petition never fully reviewed the file, and certainly never considered the submittal of January 14, 2003.

Applicant requests relief from the Petition Decisions of December 2, 2002 and May 7, 2003, holding the subject application abandoned, on one of two alternative bases. The first basis is that the Petition Decision of December 2, 2002 was moot, and thus improper. When the request for withdrawal of the holding of abandonment was filed on October 1, 2002, the PTO responded by immediately charging the Issue Fee to the undersigned's deposit account. This was an affirmative action on the part of the PTO, withdrawing the abandonment status of the subject application, by charging the Issue Fee, which was authorized to be charged prior to the deadline of August 1, 2002 (and not later, in a "resubmittal", as wrongly stated by the decider of the petition), to the deposit account of the undersigned. It is up to the PTO to determine when the issue fee is to be charged to the deposit account, and there is nothing in the rules to prevent the PTO from resubmitting a charge to the deposit account more than once. The rule cited in the Petition Decision of May 7, 2003, namely 37 CFR 1.25, while stating that charges to accounts with insufficient funds will not be accepted, certainly does not prohibit the PTO from attempting to charge the originally authorized fee a second time. In this case, the PTO determined to charge the Issue Fee, which was properly authorized within the allowable period, prior to August 1, 2002, a second time, which was successful.

Thus, since the subject application had already been restored from an abandoned status, by the PTO's action in accepting the Issue Fee on October 3, 2002, the Petition Decision of December 2, 2002 was moot. Similarly, the Petition Decision of May 7, 2003 is also moot. The application is not abandoned.

When the undersigned discussed this matter with Mr. Dixon today by telephone (and Mr. Dixon is thanked for his graciousness during that conversation), he indicated that he had no authority to decide that the subject application is not abandoned, because such a decision would require a waiver of the rules. Presumably he referred to 37 CFR 1.25. Although the undersigned attempted to explain the above rationale, and that no waiver of any rule was required in order to ascertain that the application is not in fact abandoned, he insisted that a petition under 37 CFR 1.183, asking for waiver of the rules, would be necessary, and suggested that one be filed. Accordingly, in the alternative, to the extent necessary, Applicant respectfully requests such a rule waiver in order to arrive at a holding that the subject application is not abandoned, that the Issue Fee has been paid, and that a patent should issue thereon as soon as practicable. The basis for such a ruling is that, regardless of the admitted initial error that the undersigned made in failing, for a few days, to have sufficient funds in the authorized deposit account to permit payment of the Issue Fee, the PTO has made repeated and compounded errors since then, and caused extreme delay in processing this matter, to Applicant's detriment. Initially, there is no excuse for a delay of two months in issuing the initial Notice of Abandonment. There is no excuse for not providing notice, in or prior to the Notice of Abandonment, as to the specific reason why it had been determined that the issue fee had not been paid (i.e. the insufficient funds in the deposit account). There is no excuse for subsequently charging the issue fee to that same deposit account, seven months ago, if the application were not to be restored to active status. There is no excuse for a further delay of two months in rendering the Petition Decision of

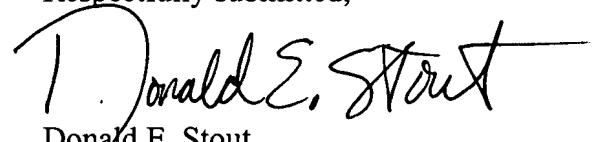
December 2, 2002. Finally, there is no excuse for the further delay, until May 7, 2003, in rendering the second Petition Decision, and then not even considering the submittal of January 14, 2002 in that decision. The PTO encourages Applicants to use deposit accounts, and touts its efforts to provide "customer service", and then exacts completely harsh and punitive penalties when an administrative error is made by an Applicant (in this case a demand for an additional \$1,300 fee for reviving the application and the loss of a year of patent term for the Applicant). Yet the PTO excuses its own repeated gaffes and failures and takes absolutely no responsibility for them, refusing to take any reasonable corrective action. Private companies which operated in such a manner would be immediately shut down.

Accordingly, simple equity requires that this application be restored from its present abandoned status. Applicant further respectfully requests that a decision on this petition, and subsequent issuance of a patent based on this application be expedited in view of the long delays which have occurred as a result of PTO inaction.

Authorization is hereby given to charge any necessary fees, including any fee required in connection with a petition under 37 CFR 1.183, to Deposit Account No. 13-5135.

Please feel free to contact the undersigned to further discuss any of the foregoing.

Respectfully submitted,



Donald E. Stout
Registration No. 34,493

May 13, 2003
Stout, Uxa, Buyan & Mullins, LLP
4 Venture, Suite 300
Irvine, CA 92618
949-450-1750 *telephone*
949-450-1764 *facsimile*

EXHIBIT A



Return To:

USPTO
Home
PageFinance
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Page**Deposit Account Statement**

Requested Statement Month: October 2002
Deposit Account Number: 135135
Name: STOUT UXA BUYAN & MULLINS L L P
Attention: DONALD E. STOUT
Address: 4 VENTURE, SUITE300
City: IRIVINE
State: CA
Zip: 92618

DATE	SEQ	POSTING REF	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
10/03	7	09561480	A-1529	2251	\$55.00	\$8,128.00
10/03	350	08482402	102105.151CI	1501	\$1,280.00	\$6,848.00
10/03	351	09035202	A-1367	1501	\$1,280.00	\$5,568.00
10/03	352	09634118	QD1-1700 DIV	1501	\$1,280.00	\$4,288.00
10/03	353	09931727	A-1661	1501	\$1,280.00	\$3,008.00
10/03	354	09791080	A-1383CON	2501	\$640.00	\$2,368.00
10/03	355	09246342	8388.24P	1501	\$1,280.00	\$1,088.00
10/04	50	10262420	A-1597CON2	2001	\$370.00	\$718.00
10/07	1	10100245	A-1011DIV	2251	\$55.00	\$663.00
10/08	4	09475495	A1579	2251	\$55.00	\$608.00
10/08	29	E-REPLENISHMENT		9203	-\$5,000.00	\$5,608.00
10/09	151	76155403		6004	\$150.00	\$5,458.00
10/11	1	10096051	A-1334CON	1251	\$110.00	\$5,348.00
10/11	147	78173147		6001	\$325.00	\$5,023.00
10/11	355	78173284		6001	\$325.00	\$4,698.00
10/16	1	09687185	A-1673	2252	\$190.00	\$4,508.00
10/17	150	78175077		7001	\$325.00	\$4,183.00
10/17	322	78175173		7001	\$325.00	\$3,858.00
10/23	10	09954505	A-1804CIP	1814	\$110.00	\$3,748.00
10/25	38	E-REPLENISHMENT		9203	-\$3,000.00	\$6,748.00
10/29	2	09479393	A-1583	2251	\$55.00	\$6,693.00
10/29	26	09226418	A-1670	1453	\$1,280.00	\$5,413.00

START BALANCE	SUM OF CHARGES	SUM OF REPLENISH	END BALANCE
\$8,183.00	\$10,770.00	\$8,000.00	\$5,413.00

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TO:Auto-reply fax to 9494501765 COMPANY:

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7-161 P.03/007 8-633

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ATTORNEYS, PARALEGALS,
CO-DEFENDANTS, AND RELATED
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MATTERS

COLLEEN L. PETRUSO, ESQ.

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FACTSIMILE COVER PAGE

DATE: 1/14/2003
TO: William R. Dixon, Jr.
FAX: 703-305-7230; 703-872-9307
FROM: Tom Stout
RE: SN 08/482, 402

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- 1) Second Request for Reconsideration
(2 pages)
- 2) Deposit Account Statement - Oct. 2002
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- 3) Deposit Account Statement -
Nov. 2002 (2 pages)

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LOUISE S. KODIM **

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Commissioner for Patents
Washington, D.C. 20231

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SECOND REQUEST FOR RECONSIDERATION OF PETITION DECISION

Dear Sir:

This is a second request for reconsideration of the petition decision mailed on December 2, 2002, and received in our offices on December 9.

On December 27, 2002, a *Request for Reconsideration of Petition Decision, Or, Alternatively, Petition for Revival of Application*, was filed via facsimile. In view of information subsequently available to the undersigned, Applicant respectfully requests that the paper filed on December 27 be superseded by the present filing. Authorizations made therein to charge certain fees to Deposit Account No. 13-5135 are hereby withdrawn.

The *Petition Decision* indicates that the application was properly abandoned for applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance dated May 1, 2002; therefore, due August 1, 2002, because there were insufficient funds in the undersigned's deposit account to effect issue fee payment. However, this point is moot. The issue fee for the subject application was successfully

charged to the aforementioned deposit account on October 3, 2002, as shown on the attached statement. Thus, the Patent & Trademark Office accepted the issue fee in question, and the application, therefore, cannot be abandoned.

Accordingly, Applicant respectfully submits that the Notice of Abandonment is moot, the application is active, and in condition for issuance.

Furthermore, Applicant requests that the petition fee of \$130 charged to Deposit Account No. 13-5135 on November 21, 2002 in connection with the subject application (as evidenced in the attached statement) be refunded by credit to said deposit account. It was improper to charge a petition fee when the issue fee had been previously accepted.

Although it is clear that no fee is due, please charge any necessary fee in connection with this submittal, and credit any refund, to Deposit Account No. 13-5135.

Please feel free to contact the undersigned to further discuss any of the foregoing.

Respectfully submitted,



Donald E. Stout
Registration No. 34,493

January 14, 2003
Stout, Uxa, Buyan & Mullins, LLP
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949-450-1750 telephone

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